TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/553,658 695 PW
Filing Date	April 21, 2000
First Named Inventor	Marvin T. Ling
Art Unit	3628
Examiner Name	Pedro R. Kanof
Attorney Docket Number	GTX-001

Total Number of Pages in This Submission

ENCLOSURES   *(Check all that apply)*

- [✔] Fee Transmittal Form
  - [✔] Fee Attached
- [ ] Amendment/Reply
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [ ] Response to Missing Parts/ Incomplete Application
  - [ ] Response to Missing Parts under 37 CFR 1.52 or 1.53

- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
- [ ] Terminal Disclaimer
- [ ] Request for Refund
- [ ] CD, Number of CD(s) _____

- [ ] After Allowance Communication to a Technology Center (TC)
- [ ] Appeal Communication to Board of Appeals and Interferences
- [✔] Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
- [ ] Proprietary Information
- [ ] Status Letter
- [✔] Other Enclosure(s) (please Identify below):

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Remarks

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual	Nicola A. Pisano Reg. No. 34,408 Luce, Forward, Hamilton & Scripps
Signature	*[signature]*
Date	June 2, 2003

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: June 2, 2003

Typed or printed	Amy K. Wilson		
Signature	*[signature]*	Date	June 2, 2003

AF/8

3600

FEE TRANSMITTAL
for FY 2002

Patent fees are subject to annual revision.

Complete if Known	
Application Number	09/553,659 690 pw
Filing Date	04/21/2000
First Named Inventor	Marvin T. Ling
Examiner Name	Redro R. Kanof
Group Art Unit	3628
Attorney Docket No.	GTX-001

TOTAL AMOUNT OF PAYMENT ($) 160.00

METHOD OF PAYMENT

1. ☐ The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit Account Number: 50-2298

Deposit Account Name: Luce, Forward, Hamilton & Scripps LLP

☑ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17

☑ Applicant claims small entity status. See 37 CFR 1.27

2. ☑ **Payment Enclosed:**
☑ Check ☐ Credit card ☐ Money Order ☐ Other

FEE CALCULATION

1. BASIC FILING FEE

Large Entity / **Small Entity**

Fee Code	Fee ($)	Fee Code	Fee ($)	Fee Description	Fee Paid
101	740	201	370	Utility filing fee	
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	

SUBTOTAL (1) ($)

2. EXTRA CLAIM FEES

	Extra Claims	Fee from below	Fee Paid
Total Claims	-20** = ___ X ___	=
Independent Claims	- 3** = ___ X ___	=
Multiple Dependent	___	=

Large Entity / **Small Entity**

Fee Code	Fee ($)	Fee Code	Fee ($)	Fee Description
103	18	203	9	Claims in excess of 20
102	84	202	42	Independent claims in excess of 3
104	280	204	140	Multiple dependent claim, if not paid
109	84	209	42	** Reissue independent claims over original patent
110	18	210	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) ($)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for *ex parte* reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	400	216	200	Extension for reply within second month	
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of Appeal	
120	320	220	(160)	Filing a brief in support of an appeal	160.
121	280	221	140	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,280	241	640	Petition to revive - unintentional	
142	1,280	242	640	Utility issue fee (or reissue)	
143	460	243	230	Design issue fee	
144	620	244	310	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Processing fee under 37 CFR 1.17(q)	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))	
179	740	279	370	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid **SUBTOTAL (3)** ($) 160.00

SUBMITTED BY

		Complete (if applicable)	
Name (Print/Type)	Nicola A. Pisano	Registration No. (Attorney/Agent)	34,408
		Telephone	(858) 720-6300
Signature	*Nicola A. Pisano*	Date	06/02/2003

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant	:	Marvin T. Ling
Serial No.	:	09/553,659 Confirmation No. 6472
Filed	:	April 21, 2000
For	:	METHODS AND APPARATUS FOR CONDUCTING ELECTRONIC COMMERCE TRANSACTIONS USING ELECTRONIC TOKENS
Group Art Unit	:	3628
Examiner	:	Pedro R. Kanof

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S BRIEF

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Table of Contents

Introduction

This brief is filed pursuant to 37 C.F.R. § 1.192 to appeal the Final Rejection dated October 2, 2002 of claims 1-27 of the above-identified application. A request for oral hearing on this matter was filed with the Notice of Appeal on April 1, 2003.

(1) Real Party In Interest

The real party in interest in this proceeding is the assignee of the present application, PayByClick Corporation, 15333 North Pima Rd., Suite 105, Scottsdale, Arizona 85260. PayByClick Corporation holds all right, title and interest in and to the present invention and pending application by virtue of an assignment dated August 7, 2002, recorded in the United States Patent and Trademark Office on November 25, 2002, at Reel 13627, beginning at Frame 29.

(2) Related Appeals And Interferences

None.

(3) Status Of Claims

Claims 1-27 are pending in the application.

Claims 1-27 have been rejected under 35 U.S.C. § 112, first paragraph, "as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention."

Claim 27 stands rejected as anticipated, 35 U.S.C. § 102(b), by Williams et al., U.S. Patent No. 5,815,657 ("Williams").

Claims 1-27 stand rejected as obvious, 35 U.S.C. § 103(a),
over Williams in view of Fujimoto, U.S. Patent No. 6,018,720
("Fujimoto").

Because the Examiner rejected applicant's contention that
"Williams and Fujimoto fail to show or suggest applicant's
claimed features of issuing electronic tokens from a vendor
without requiring communication with a financial institution and
making purchases without disclosing the user's personal
information to the vendor" as lacking support in the
specification, the Examiner maintained his previous rejection
over the combination of Williams and Fujimoto.

Rejection of all of claims 1-27 is appealed herein.

(4)   Status Of The Amendments

No amendments have been filed subsequent to the Final
Action.

(5)   Summary Of The Invention

The present invention relates to electronic commerce
arrangements in which electronic tokens are issued to a
registered user for use in purchasing goods and services at a
vendor's website. As set forth in independent claims 1 and 27,
a user may establish an account with a vendor, wherein the user
provides the vendor with credit and address information on a
one-time basis. The vendor then issues electronic tokens
without requiring communication with a financial institution,
and credits those tokens to the user's account. *See, e.g.*,
specification at page 8, lines 6-25, page 11, lines 8 to page
12, line 13, page 17, line 29 to page 21, line 6, and FIGS. 3-4.

As further recited in claims 1 and 27, the vendor provides
through its website goods and services for sale that are
denominated in units of amounts, and permits the previously

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registered user to select amongst these goods and services for purchase. The total price of any proposed sale is computed in units of electronic tokens. *See, e.g.,* specification at page 8, lines 26-31, page 23, line 3 to page 26, line 16, page 27, line 25 to page 31, line 18 and FIGS. 6-9.

Further, as recited in claims 1 and 27, if the user's account contains electronic tokens having a value greater than or equal to the proposed total price, the user may make the purchase without requiring the user to disclose personal information to the vendor to complete the transaction. *See, e.g.,* specification at page 8, line 32 to page 9, line 8, page 26, line 17 to page 27, line 24, page 31, line 19 to page 34, line 12 and FIGS. 5 and 10.

The principal advantages of the methods and apparatus of the present invention, as recited in the claims and described in the specification, are two-fold:

First, the methods and apparatus of the present invention enable electronic commerce transactions at micropayment amounts to become cost-effective. It does this by permitting the vendor to issue tokens to a registered user without requiring communication with a financial institution for each transaction. As described in the specification at page 7, lines 29-34 and page 12, lines 14-32, this feature reduces overhead for the vendor (and ultimately the consumer) by reducing per-transaction charges. For example, a vendor may choose to accumulate multiple small charges before seeking reimbursement from a credit card company. *Compare,* specification at page 6, line 14 to page 7, line 8.

Second, the methods and apparatus of the present invention enable electronic commerce transactions to be conducted with significantly reduced risks to the user's privacy, compared to previously known systems. As recited in the claims and

described in the specification, it does this by permitting transactions to be conducted between a registered user and the vendor *without* requiring the user to provide sensitive credit or personal information for each transaction. *See*, specification at page 3, lines 28-31, page 11, lines 22-32 and page 12, line 33 to page 13, line 14. Importantly, because the user does not have to transmit sensitive credit or personal information during each purchase transaction, the risk that this information could be intercepted by a third party is significantly reduced, and privacy correspondingly enhanced. *See*, specification at page 13, lines 1-9. Indeed, if a user should select an off-line method of establishing his or her user account, as described in the specification at page 19, line 22 to page 20, line 16 (and the left hand column in FIG. 3), the user may never need to provide his or her credit information on-line.

(6) Statement Of The Issues Presented For Review

(1) Does the specification describe methods and apparatus for conducting electronic commerce in which a vendor may issue tokens without requiring communication with a financial institution and a user may conduct a purchase transaction without disclosing sensitive personal or credit information in connection with that transaction?

(2) Do Williams or Fujimoto, alone or in combination, disclose methods and apparatus for conducting electronic commerce in which a vendor may issue tokens without requiring communication with a financial institution and a user may conduct a purchase transaction without disclosing sensitive personal or credit information in connection with that transaction?

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(7) Grouping Of Claims

Appellant respectfully submits that the central issue for determination in this appeal is whether the specification supports the claims as presented pursuant to 35 U.S.C. § 112, first paragraph, and thus all of claims 1-27 stand or fall together.

(8) Argument

A. The Specification Provides § 112 Support For The Pending Claims

(i) The Rejection

Appellant respectfully submits that the specification of the present application supports the recitations of the pending claims as required by 35 U.S.C. § 112, first paragraph.

In an Office action dated February 1, 2002, the Examiner rejected claim 27 as anticipated by Williams and claims 1-27 as obvious over Williams and Fujimoto. In an amendment filed June 3, 2002, appellant amended claim 1 to recite the step of, after the user has opened a user account with the vendor:

> "issuing one or more electronic tokens from the vendor to the user without requiring communication with a financial institution, and adding the one or more electronic tokens issued by the vendor to the user account."

Claim 1 also was amended to recite, after a total price had been computed for products and services selected for purchase by the user, that:

> "if the user account contains electronic tokens having a value equal to or greater than the total price, permitting the user to purchase the selected subset of the products and services without requiring the user to disclose personal information to the vendor ..."

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Appellant incorporated corresponding amendments into the
"electronic token sale" and "selection" routines of apparatus
claim 27. Appellant then argued that neither Williams nor
Fujimoto, alone or in combination, suggested either of these
features.

The Final Action dated October 2, 2002 rejected claims 1-27
on the ground that:

> "[c]laims 1 and 27 ... contain[] subject matter which
> was not described in the specification in such a way
> as to reasonably convey to one skilled in the relevant
> art that the inventor(s), at the time the application
> was filed, had possession of the claimed invention.
> The new features in Claims 1 and 27 are not supported
> by the Specification, in particular see page 19."

The Final action maintained the rejections based on Williams and
Fujimoto set forth in the Office action dated February 1, 2002,
on the grounds that appellant's distinctions were moot because
they lacked support in the specification. The rejection under
35 U.S.C. § 112 is incorrect, and the rejections based on
§§ 102(b) and 103(a) must likewise fail.

(ii) The § 112, First Paragraph Support

Appellant respectfully submits that, as set forth below,
the rejection is plainly erroneous and ample support is provided
in the specification for the pending claims. The pending
application specifically identifies as a shortcoming of
previously-known electronic commerce systems that those systems
require the user to transmit sensitive personal and credit
information in connection with each on-line transaction. *See*
specification at page 3, lines 27-31:

> "It would also be desirable for ASPs [application
> service providers] *to minimize or limit the frequency
> of asking the purchaser to transmit the user's
> private, sensitive information, such as credit card
> information.*" (emphasis added).

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Additionally, or in the alternative, previously known electronic commerce systems require the use of credit cards or a central banking organization to facilitate purchases, thus requiring the vendor to communicate with the banking organization or other financial institution and incur substantial overhead (especially where the price per purchase is very small). This is described in the specification at page 4, line 12 to page 7, line 8. Accordingly, the present application states that:

> "[i]t is an object of the present invention to provide electronic currency or tokens that may be issued and used with minimal overhead, and **that do not require on-line communication with a bank or other organization to issue or use the tokens.**" (emphasis added).

The methods and apparatus of the present invention are then described as solving these problems by providing methods and apparatus wherein sensitive credit information need only be disclosed on-line to the vendor at the time the user's account is first established. Alternatively, if the off-line method described in the specification is used, credit information never need be transmitted on-line. *See, e.g.,* specification at page 18, line 7 to page 21, line 6 and FIG. 3.

When a registered user then visits a vendor's website to select and purchase goods or services, and the user has sufficient tokens in his or her account, the user **need not** disclose or transmit personal or credit information to the vendor to complete the transaction. This aspect of the present invention is made plain in the Detailed Description of the Invention at page 11, lines 22-32:

> "Since electronic tokens are used for the business transaction, **the need to transmit the user's credit card number and other personal sensitive information between the user's computer and the vendor's computer**

for each transaction is eliminated.... [and] security for the user's personal sensitive information is improved." (emphasis added).

Page 12, line 33 to page 13, line 5 further describes this aspect of the invention:

"A further benefit of using vendor-issued tokens of the present invention is that privacy risks are decreased. *Since all purchases or business transactions are done using tokens, very little or no personal sensitive information, such as the user's credit card number, need be transmitted over communication lines*, such as the Internet." (emphasis added).

The Detailed Description of the Invention also emphasizes the freedom that the methods and apparatus of the present invention give the vendor in issuing tokens that need not be settled through a central bank, and therefore reduce the vendor's overhead associated with purchase transactions, especially for micropayment amounts. Additionally, because the user and vendor can arrange for suitable payment arrangements via off-line methods, such as personal check, there need be no direct association between a purchase transaction and communication with a financial institution to settle accounts for a transaction. Instead, as stated in the specification at page 12, lines 20-32:

"Because the user need not use a credit card for his purchases, *it is unnecessary for the user to have a credit card, of for the user's or vendor's computer to interact over the network with a bank or other financial institution* to process credit card transactions. Additionally, since orders can be handled without credit card transactions, the overhead associated with such transactions can be reduced or eliminated, permitting micropayments...." (emphasis added).

Each of the foregoing features is recited in independent claims 1 and 27, from which all other claims now on appeal depend. The foregoing remarks demonstrate that once the user's account has been established, the vendor credits the user's account with an amount of tokens, without requiring communication with a financial institution. Moreover, in conducting purchase transactions with the established account, the user is not required to disclose personal information to the vendor to complete the transaction. Consequently, the risk of interception of that user's personal or credit information as a result of that transaction is substantially reduced.

Appellant submits that the reference in the Final Action to page 19 of the specification does not require a different result. Instead, the portion of the specification at page 19 addresses an off-line registration process that a user may use *to become* a registered user, and relates to the first element of claim 1 and the "registration routine" of claim 27. That portion of the specification has nothing to do with *issuance of tokens* without communication with a financial institution or the *purchase step* conducted by a registered user as recited in the pending claims.

(iii) The Specification Is Enabling

The Final Action asserts that, at the time the application was filed, the appellant did not have possession of the invention as recited in the pending claims, *supra*, page 6. As appellant demonstrates hereinabove, the specification provides ample support for the features now relied upon for patentability. In particular, the above-referenced portions of the specification individually identify the drawbacks of the previously known systems. The Detailed Description of the

Invention then explains how the methods and apparatus of the present invention advantageously solve those problems.

FIG. 1 describes how the apparatus of the present invention is arranged, and illustratively comprises a conventional server configured for use with the Internet. FIG. 2 describes the data structures used to implement the methods of the present invention. In conjunction with the written description and detailed flow charts set forth in FIGS. 3-5 and 10, and the illustrative screen displays described with respect to FIGS. 6-9, implementation and use of the methods and apparatus of the present invention would have been, and is, well within the ability of a skilled Internet programmer, and would not require undue experimentation.

More specifically, the flow chart of FIG. 3, and the associated written description at page 17, line 29 to page 21, line 6, explains how a user may register with a vendor using either on-line or off-line methods. The vendor retains the registration information in its user database, and depending upon the types and costs of services or products offered at its website, may issue the user a specified amount of tokens without communicating with a financial institution. Once the user is registered and the vendor has credited the user's account with an amount of tokens, the vendor notifies the user of his available number of tokens, and provides the user with identifying information, e.g., an account number or PIN number, with which to make purchases.

The flow chart of FIG. 4 describes how, once a user is registered, he or she may browse the vendor's website, select services or products for purchase, and complete the purchase. Because the user need only identify himself or herself by account number and, for example, PIN number, the user need not transmit credit card or other personal sensitive information to

complete the transaction. If the total price of the proposed transaction is greater than the available amount of tokens in the user's account, the user may elect to purchase additional tokens, as described in conjunction with FIG. 4.

In view of the foregoing, appellant submits that there can be no serious dispute that a skilled Internet programmer, with the specification and figures of the present application in hand, could not have implemented the present invention. Appellant accordingly submits that the present invention, as recited in the pending claims, is fully enabled.

Appellant also confirms that the best mode of practicing the invention, as known to the appellant at the time the present application was filed, is described in the pending application.

B. The Pending Claims Patentably Distinguish Over Williams and Fujimoto

(i) The Rejections

Appellant respectfully submits that the pending claims patentably distinguish over the prior art relied upon in the Final Action. As noted above, in the Office action dated February 1, 2002, claim 27 was rejected as anticipated by Williams while claims 1-27 were rejected as obvious over Williams and Fujimoto.

As further noted above, appellant amended claim 1 to recite steps of:

> "issuing one or more electronic tokens from the vendor to the user without requiring communication with a financial institution, and adding the one or more electronic tokens issued by the vendor to the user account"

and

> "if the user account contains electronic tokens having a value equal to or greater than the total price, permitting the user to purchase the selected subset of

the products and services <u>without requiring the user</u>
<u>to disclose personal information to the vendor</u> ...″

Appellant incorporated corresponding amendments into the
"electronic token sale″ and "selection″ routines of apparatus
claim 27.

Because the Examiner erroneously concluded that the
additional limitations added by the appellant in his June 3,
2002, amendment lacked support in the specification, *supra*, the
Examiner erroneously disregarded those limitations in assessing
patentability of the pending claims. As appellant has
demonstrated, *supra*, the specification provides ample support
for these recitations, and accordingly the prior art-based
rejections must fail.

(ii) The Williams Patent

Williams discloses an electronic monetary system that
emulates a wallet or purse containing several payment
instruments that may be selected by a user when making
electronic commerce purchases. Each payment instrument in the
wallet is issued by a financial institution and is controlled by
issuance of a certificate by the financial institution. *See,*
e.g., col. 11, lines 5-15 and 31-52 and FIGS. 1B and 2.

As is apparent from the basic architecture of system
described in FIGS. 1B and 2 of Williams, Bank Website 182 is an
integral part of the system, and that system plainly requires
communication with a financial institution when payment
instruments are issued.

Moreover, the FIGS. 10-12 describe a preferred embodiment
of a Payment Instrument and Authorization sequence in Williams,
wherein bitmap images of the user's credit cards are used to
complete transactions. As described at col. 21, lines 32-34,
the images "[are] virtually identical to the user's actual

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card[s], so such information as payment instrument holder's name, instrument name, membership period and expiration date" are displayed.

When a user of the Williams's system uses a given payment instrument to pay for a product on a vendor's web site, the certificate associated with the payment instrument is transmitted from the user's computer to the vendor's web site. *See, e.g.*, col. 13, line 35 to col. 14, line 23 and col. 36, lines 44-49. The certificate contains the user's personal and financial information such as the user's social security number, bank account numbers, and credit card numbers. *See* FIG. 29 and col. 36, lines 63-12. Accordingly, the Williams system requires that the user's personal information be disclosed to the vendor in connection with each purchase.

Because Williams requires that the vendor interact with a financial institution when issuing payment instruments and because Williams requires that the user's personal information be disclosed to the vendor during purchases, it cannot anticipate claim 27.

(iii) The Fujimoto Patent

Fujimoto discloses a data delivery system that allows users to purchase software with a rewritable record medium. The rewritable record medium contains a data area "which includes purchaser's inherent data, purchase data and accounting data." *See, e.g.*, col. 2, lines 53-54. The purchaser's inherent data consists of user's personal information, which may include the user's gender and date of birth, as shown in FIG. 4.

The data stored in the rewritable record medium is transmitted to a software deliverer and matched to corresponding data stored in a computer maintained by the software deliverer. A match of the user's inherent data indicates that the user is

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authorized to purchase software from the software deliverer and a match of the accounting data indicates that an accounting operation that results in the purchase of the software by the user may be performed. Accordingly, as in Williams, each software purchase transaction in Fujimoto requires the disclosure of the user's personal information to the software deliverer.

Fujimoto also does not remedy the deficiencies of Williams with respect to the need to communicate with a financial institution. Specifically, nothing in Fujimoto teaches or suggests applicant's claimed method of enabling a vendor to issue electronic tokens to a user without requiring communication with a financial institution.

Appellant respectfully submits that neither Williams nor Fujimoto, alone or in combination, teach or suggest appellant's claimed features of (1) issuing electronic tokens from a vendor without requiring communication with a financial institution and (2) making purchases without disclosing the user's personal information to the vendor, as recited in claims 1 and 27.

Appellant notes that the Final Action takes "Official Notice" of numerous inventive aspects recited in the dependent claims. *See, e.g.*, the § 103(a) rejections of claims 6, 13, 14, 19, 20, 21, 22, 23, 24 and 25. While appellant strenuously disagrees with these rejections, it is noteworthy that nowhere does the Final Action suggest that features (1) and (2) above would have been known from, or obvious in view of, the prior art.[*]
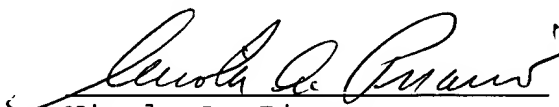
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[*]   So as to avoid unduly lengthening this Appeal Brief, appellant relies on these two features to patentably distinguish over the prior art, and submits that it is unnecessary to address the rejections of the independent claims separately.

Because the Examiner has not contended that the principal features relied upon by the appellant either were in the prior art or would have been obvious in view of the prior art, appellant submits that it is not necessary to rebut an unstated contention that motivation existed for making the claimed combination. Indeed, neither of Williams nor Fujimoto, taken alone or in combination, suggest the inventive limitations of claims 1 and 27. Appellant accordingly submits that claims 2-26, which depend from claim 1, are allowable for at least the same reasons as claim 1.

Conclusion

In view of the foregoing, appellant respectfully submits that the pending claims are fully supported by the specification and patentably distinguish over the prior art. Appellant respectfully requests that the rejections under 35 U.S.C. §§ 112, 102(b) and 103(a) be reversed and that the above-identified application be passed to issue.

Respectfully submitted,

Nicola A. Pisano
Registration No: 34,408
Attorney for Applicant

c/o LUCE, FORWARD,
HAMILTON & SCRIPPS, LLP
11988 El Camino Real, Suite 200
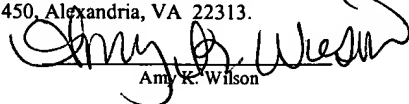San Diego, California 92130
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Appendix

1.   A method of conducting electronic commerce, the method comprising:

opening a user account with a vendor for a user;

issuing one or more electronic tokens from the vendor to the user without requiring communication with a financial institution, and adding the one or more electronic tokens issued by the vendor to the user account;

providing products and services that may be purchased through the vendor, wherein prices for the products and services are listed in units of electronic tokens;

permitting the user to select a subset of the products and services for purchase;

computing a total price for the selected subset of the products and services in units of electronic tokens; and

if the user account contains electronic tokens having a value equal to or greater than the total price, permitting the user to purchase the selected subset of the products and services without requiring the user to disclose personal information to the vendor, and subtracting the total price from the user account.

2.   The method of claim 1, wherein issuing one or more electronic tokens from the vendor to the user comprises permitting the user to purchase the one or more electronic tokens from the vendor.

3.   The method of claim 2, wherein permitting the user to purchase the one or more electronic tokens from the vendor comprises permitting the user to conduct an on—line

transaction using a credit card to purchase the one or more electronic tokens.

4. The method of claim 2, wherein permitting the user to purchase the one or more electronic tokens from the vendor comprises permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens.

5. The method of claim 4, wherein permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to use a purchase order to purchase the one or more electronic tokens.

6. The method of claim 4, wherein permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to request to be billed for the one or more electronic tokens.

7. The method of claim 4, wherein permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to use phone, fax, mail, or e-mail to purchase the one or more electronic tokens.

8. The method of claim 4, wherein permitting the user to conduct an off-line transaction to purchase the one or more electronic tokens comprises permitting the user to purchase electronic tokens without using a credit card.

9. The method of claim 1, wherein issuing the one or more electronic tokens comprises setting a price for the one or more electronic tokens, the price determined by the vendor.

10. The method of claim 1, wherein opening a user account with a vendor comprises registering the user with the vendor.

11. The method of claim 10, wherein registering the user with the vendor comprises recording personal information about the user in a database maintained by the vendor.

12. The method of claim 11, wherein registering the user with the vendor comprises acquiring personal information about the user through off-line communications.

13. The method of claim 10, wherein opening a user account with the vendor further comprises issuing a predetermined minimum number of electronic tokens to the user.

14. The method of claim 1, further comprising issuing additional electronic tokens to the user.

15. The method of claim 14, wherein issuing additional electronic tokens to the user comprises permitting the user to purchase additional electronic tokens if the user account does not contain enough electronic tokens to cover the total price of the selected subset of products and services.

16. The method of claim 14, wherein issuing additional electronic tokens to the user comprises permitting the user to purchase additional electronic tokens through an on-line transaction using a credit card, without disrupting a process of selecting products and services.

17. The method of claim 1, further comprising displaying a number of available electronic tokens in the user account on a computer screen.

18. The method of claim 1, wherein providing products and services that may be purchased through the vendor comprises providing software to be purchased or rented in exchange for electronic tokens.

19. The method of claim 18, wherein providing software to be purchased or rented comprises providing software that is rented for a limited time.

20. The method of claim 18, wherein providing software to be purchased or rented comprises providing software that is rented for a limited number of uses.

21. The method of claim 18, wherein providing software to be purchased or rented comprises providing software that is rented for processing a given task for a specific number of times.

22. The method of claim 18, wherein providing software to be purchased or rented further comprises permitting the user to extend the software rental in exchange for electronic tokens.

23. The method of claim 18, wherein providing software to be purchased or rented further comprises permitting the user to convert rental software to purchased software in exchange for electronic tokens.

24. The method of claim 18, wherein providing software to be purchased or rented further comprises determining if a selected software program is already installed on a user's computer, downloading and installing the selected software program if the selected software program is not already installed on the user's computer, and sending an authorization code, without downloading the selected software program, if the selected software program is already installed on the user's computer.

25. The method of claim 1, further comprising transferring electronic tokens from the user to a second user.

26. The method of claim 1, wherein providing products and services that may be purchased through the vendor comprises listing products and services for sale by one or more users of a Web site maintained by the vendor.

27. A server operated by a vendor that provides products for sale or rental through a network, the server comprising:

a network interface through which the server communicates with a user over the network;

a database;

a memory;

a processor that executes software stored in the memory, the software including one or more programmed routines, the programmed routines comprising:

a registration routine that opens a user account in the database for the user;

an electronic token sale routine that issues one or more electronic tokens from the vendor to the user without requiring communication with a financial institution, and adds the one or more electronic tokens to the user account;

a display routine that displays the prices of the products in units of electronic tokens;

a selection routine that permits the user to select a subset of the products for purchase without requiring the user to disclose personal information to the vendor, a total price of the subset of the products being computed in units of electronic tokens; and

a purchase routine that determines if the user account contains electronic tokens having a value equal to or greater than the total price, and if so, subtracts the total price from the user account.